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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,336

04/07/2006

Hironori Kobayashi

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EXAMINER

DOLLINGER, MICHAEL M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,336	<b>Applicant(s)</b> KOBAYASHI ET AL.	
	<b>Examiner</b> MIKE DOLLINGER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/17/2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. Claim 1 limits the coupling agent (C) has a hydroxyl group in its molecule and is obtained by a reaction of an imidazole compound and 3-glycidoxypopyltrimethoxysilane or a reaction of an imidazole compound and 3-methacryloxypropyltrimethoxysilane. However, Applicants' clearly state that the silane coupling agent imidazole silane B which is obtained by the reaction of an imidazole compound and 3-methacryloxypropyltrimethoxysilane *does not have a hydroxyl group* [0026]. This makes the language of claim 1 confusing because it is unclear whether the second reaction product (the reaction product of an imidazole compound and 3-methacryloxypropyltrimethoxysilane) is required to have a hydroxyl. Applicants are required to clarify whether the second reaction product of claim 1 requires a hydroxyl group.
3. Claims 2, 3 and 5-9 are indefinite because they depend from claim 1.
4. Any disclosure of a compound that is a reaction product of an imidazole compound and 3-methacryloxypropyltrimethoxysilane will be considered to meet the limitations of silane coupling agent (C) of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takei et al (US 5,391,664) in view of Kumagai et al (US 6,710,181 B2)
6. Takei et al disclose polyurethanes derived from a hydroxyl functional polymer (A) and a polyfunctional isocyanate compound (g) wherein the molar ratio NCO/OH is preferably in the range of from 0.8 to 1.2 [column 15 lines 62-68]. The polymer (A) contains vinyl-based monomers (a) including (meth)acrylic and acid alkyl (meth)acrylates [column 5 line 27] and perfluoroethylene [column 5 line 57]. The polyfunctional isocyanates include tolylene diisocyanate (TDI), diphenylmethane 4,4'-diisocyanate, hexamethylene diisocyanate (HDI), and isophorone diisocyanate [column 15 lines 30-38], as well as biurets including SUMIDUR N series [column 15 lines 38-40]. The reaction mixture may also include polyols other than polymer (A) including polyether polyol and polyester polyol [column 15 lines 3-9]. The polyurethane resins may be used for applications such as waterproof for paint film [column 19 line 26-27] or for a paint compositions [column 19 line 65 through column 20 line 5], adhesives [column 19 lines 27-28], a urethane foam [column 19 lines 31-32], and a thermosetting or thermoplastic type elastomer [column 19 lines 33-34].

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7. Takei et al do not disclose the use of a silane coupling agent containing an imidazole group.

8. Kumagai et al disclose resin additive formed from the reaction of an imidazole [column 2 formula (1)] and a silane compound with a glycidoxy groups [column 3 formula (2)]. An example of the silane compound 3-glycidoxypropyltrimethoxysilane [column 4 line 42]. Kumagai et al teach that resin additives may be used with polyurethane resins [column 5 lines 59] and fluororesin [column 5 line 65] in an amount of preferably 0.1 to 20 parts by weight per 100 parts by weight of the resin [column 5 lines 43-47]. Kumagai et al also teach that the resin additives improve resin strength [column 5 lines 53-56] and adhesion to metals such as copper, steel or aluminum or an inorganic material such as glass fiber, silica, aluminum oxide or aluminum hydroxide [column 2 lines 22-26].

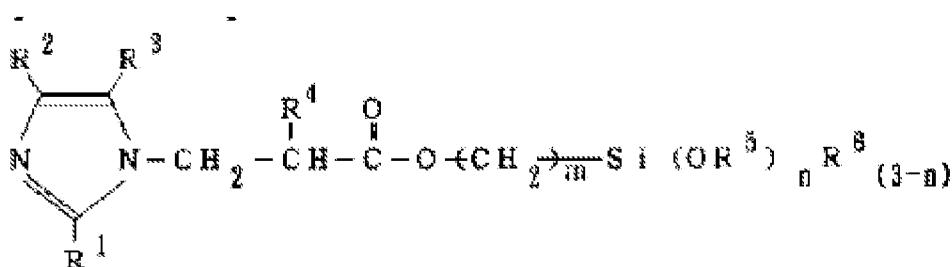
9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined an imidazole containing silane coupling agent with a polyol and polyisocyanate containing resin composition because Takei et al teach that it is within the skill of the art to make polyurethane compositions from a polyol and a polyisocyanate and Kumagai et al teach that it is within the skill of the art to combine a polyurethane with a resin additive obtained from reacting an imidazole with a silane compound containing a glycidoxy group. One would have been motivated to do this because Kumagai et al teach that the silane coupling agent improves adhesion to various materials and also improves mechanical strength of the resin. This is combining prior art elements according to known methods to yield predictable results. Absent any

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evidence to the contrary, there would have been a reasonable expectation of success in achieving improved adhesion and mechanical strength in a polyurethane resin by adding a silane coupling agent reacted with an imidazole compound.

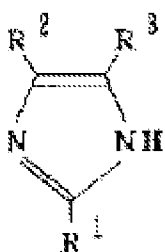
10. Claims 1-3 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takei et al (US 5,391,664), discussed above, in view of Kumagai (JP 2000-297094 A).

11. Kumagai disclose a resin additive for improving mechanical strength of a resin and the adhesion to metal or glass fibers [0001] of the formula (1):

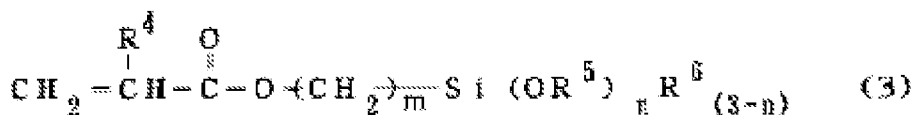


(1) [0008]

obtained by reacting an imidazole of formula (2) with an acrylic silane of formula (3):



(2)



(3)

[0011].

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Kumagai teaches that the resin additive should be used in an amount of 0.001 to 50 parts by weight per 100 parts by weight of resin [0021]. Kumagai also teaches that the resin additive improves adhesion properties of the resin to metals [0028]. The additive of the inventive examples is a reaction product of methacryloxypropyltrimethoxysilane and imidazole [0022]. From the disclosure of methacryloxypropyltrimethoxysilane one having ordinary skill in the art would at once envisage 1-, 2- and 3-methacryloxypropyltrimethoxysilane.

12. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined an imidazole containing silane coupling agent with a polyol and polyisocyanate containing resin composition because Takei et al teach that it is within the skill of the art to make polyurethane compositions from a polyol and a polyisocyanate and Kumagai teaches that it is within the skill of the art to produce a resin additive obtained from reacting an imidazole with an acrylic silane compound. One would have been motivated to do this because Kumagai teaches that the silane coupling agent improves adhesion to various materials and also improves mechanical strength of the resin. This is combining prior art elements according to known methods to yield predictable results. Absent any evidence to the contrary, there would have been a reasonable expectation of success in achieving improved adhesion and mechanical strength in a polyurethane resin by adding a silane coupling agent reacted with an imidazole compound.

### ***Response to Arguments***

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13. Applicant's arguments filed 02/17/2009 have been fully considered but they are not persuasive. Applicants' arguments are confusing. Applicants appear to be arguing that Kumagai teaches addition of an imidazole/organic compound for reasons other than Applicants' reasons for adding compound (C). This argument is not convincing because it is irrelevant whether or not the prior art's reason for adding compound (C) is the same as Applicants' reasons so long as the prior art teaches and provides motivation to one having ordinary skill in the art to prepare the resin composition of the present claims.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIKE DOLLINGER whose telephone number is (571)270-5464. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/mmd/

/Randy Gulakowski/

Supervisory Patent Examiner, Art Unit 1796